

compositions) with different uses. The Examiner alleged that separate searches will clearly be required for each group.

In response to the restriction requirement, applicants hereby elect, with traverse, to prosecute the invention identified by the Examiner as Group I, claims 87-96, 111-113, 126-135, and 150-152.

Applicants, however, respectfully request that the Examiner reconsider and withdraw the restriction requirement.

A. Claims 87-113, 117-119, 122-124, 126-152, 156-158, and 161-163 Should Be Examined Together

Applicants maintain that the Examiner has improperly required restriction among purported Groups I, II, III, VI and VIII, because the alleged inventions of these Groups are not independent inventions as defined in M.P.E.P. §808.01 which states that inventions are independent "where they are not connected in design, operation, or effect under the disclosure of the particular application under consideration." (Emphasis added) Applicants contend that the alleged inventions of Groups I, II, III, VI, and VIII are connected in that one aspect of applicants' invention is a DNA which encodes a modified HIV-1 envelope glycoprotein. The DNA of applicants' invention (i.e. claims 87-96, 111-113, 126-135 and 150-152) may be inserted into a non-replicating viral vector (i.e. claims 97-104 and 136-143) or host cell (i.e. claims 105-110 and 144-149), which DNA or non-replicating viral vector may be present in a vaccine (i.e. claims 117-119, 122-124, 156-158 and 161-163). Accordingly, applicants maintain that the alleged inventions of Groups I-III, VI and VIII are not unrelated or independent as defined in M.P.E.P. §808.01, and should be examined together.

In addition applicants maintain that claim 87 is a linking claim to its dependent claims 88-113, 117-119, 122-124, 126-152, 156-158, and 161-163. According to M.P.E.P. §809.03, a linking claim prevents restriction between inventions that can otherwise be shown to be divisible. In addition, according to M.P.E.P. §809, the "linking claim must be examined with the invention elected, and should any linking claim be allowed, the restriction requirement must be withdrawn. Any claim(s) directed to the non-elected invention(s), previously withdrawn from consideration, which depends from or includes all the limitations of the allowable linking claim must be rejoined and will be fully examined for patentability."

Accordingly, the restriction as set forth between purported Groups I, II, III, VI and VIII is improper and claims 87-113, 117-119, 122-124, 126-152, 156-158, and 161-163 should be examined together in this application.

B. The Restriction Requirement Is Improper In Its Entirety

Applicants respectfully disagree with the Examiner's assertion of restrictable subject matter set forth in the October 5, 2006 Office Action. Under M.P.E.P. §803, the Examiner must examine the application on the merits if examination can be made without a serious burden, even if the application would include claims to distinct inventions. That is, there are two criteria for a proper requirement for restriction: (1) the invention must be independent or distinct, and (2) there must be a serious burden on the Examiner if restriction were not required.

Applicants respectfully submit that there would not be a serious burden on the Examiner if restriction were not required, because a search of the prior art relevant to the claims 114-116, 120,

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121, 129, 153-155, 159, 160, and 164, i.e. Groups VI, V, VII and IX, would not pose a serious burden once the prior art for claims 87-113, 117-119, 122-124, 126-152, 156-158, and 161-163, i.e. Groups I-III, VI and VIII, has been identified. Applicants maintain that identifying any prior art for the DNA which encodes the modified envelope glycoprotein, i.e. claims 87-113, 117-119, 122-124, 126-152, 156-158, and 161-163, would necessarily identify the protein product which is the modified envelope glycoprotein, and as such, identify the prior art for claims 114-116, 120, 121, 129, 153-155, 159, 160, and 164, i.e. Groups IV, V, VII, and IX. Therefore, applicants maintain that there is no burden on the Examiner to examine Groups I-IX together in the subject application.

In view of the foregoing, applicants maintain that restriction is not proper under 35 U.S.C. §121, and respectfully request that the Examiner reconsider and withdraw the requirement for restriction.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicant's undersigned attorney invites the Examiner to telephone him at the number provided below.